

REMARKS

Claims 1 and 9 were amended and new claims 13-14 were introduced for consideration. Therefore, claims 1-14 are currently pending in this application.

PRIORITY

The Office Action states that the specification fails to provide support for a "CPU" on a bonus apparatus and, due to that, this patent application is therefore not entitled to any priority claim.

Applicant respectfully traverses and does not concede the propriety of this rejection. However, in the interests of expediting the prosecution of this application, Applicant has amended the various instances of "CPU" to --microprocessor-- which is used in Fig. 3 (reference numeral 32) and is described in the specification at paragraphs [0037] – [0043]. Due to this, Applicant respectfully submits that any questions about the priority claim have been resolved. Therefore, Applicant respectfully requests that the Examiner to consider the priority date of this application to be that of the original filing, for which priority has been claimed. Specifically, the priority date is October 2, 1992 – the filing date of U.S. Patent No. 5,292,127.

CLAIM REJECTIONS UNDER 35 § U.S.C. 112, FIRST PARAGRAPH

Claims 1-12 were rejected under 35 § U.S.C. 112, first paragraph, as based on a disclosure which is allegedly not enabled over the use of the term "CPU" in the claims.

All occurrences of "CPU" have been amended to --microprocessor-- which, as mentioned in the previous section, is described in reference to Fig. 3. Additional support for use of a microprocessor, on game units can be found at Fig. 8 (reference numeral 110, paragraphs [0056] – [0064]) and Fig. 17 (reference numeral 110, paragraph [0079]).

Applicant respectfully requests withdrawal of the § U.S.C. 112, first paragraph rejections.

CLAIM REJECTIONS UNDER 35 § U.S.C. 103(a)

Claims 1-12 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Ishida (U.S. Patent No. 4,964,638) in view of Johns (U.S. Patent No. 2,926,915). Applicant respectfully traverses the rejection and does not concede the propriety of the rejection.

The U.S. Patent and Trademark Office has issued guidelines for determining obviousness under 35 U.S.C. § 103 in view of the Supreme Court's decision in KSR International Co. v. Teleflex inc. (refer to Federal Register / Vol. 72, No. 195 at 57526). Consistent with past practice, however, the guidelines still require Examiners, when basing rejections on the combination of prior art, to articulate either 1) "a finding that the prior art included each element claimed," (refer to Federal Register / Vol. 72, No. 195 at 57529); or 2) " a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available

to one of ordinary skill in the art, to modify the references or to combine reference teachings.” (Refer to Federal Register / Vol. 72, No. 195 at 57534.)

Independent claims 1 and 9 are rejected in summary fashion as rendered obvious by the combination of Ishida and Johns. Applicant respectfully traverses this rejection. Ishida is directed to a system which allows for control of slot machines and generation of higher progressive bonuses for slot machines so that players do not lose interest in playing the slot machines after a jackpot is awarded. See Ishida, col. 1, lines 34-48. Ishida is specifically directed to slot machines, a classic game of chance and not skill. For example, slot machines (and no other type of game) are mentioned at least seven times in column 3 of Ishida alone. The Office Action points out no instance of Ishida working with anything other than slot machines, which clearly have the problem mentioned in col. 1 of Ishida.

In contrast, games of skill do not have this problem. For example, a player of a game of skill may be expected to play in an attempt to gain a high score, evidencing the player’s prowess. Similarly, the player may expect to receive greater rewards for higher scores on a game of skill, and the player may thus be enticed to play the game of skill for practice, regardless of any progressive jackpot. Slot machines do not afford a similar opportunity for practice. Johns addresses this point at col. 4, lines 33-35, indicating that a skillful player may accumulate one or more tickets.

Thus, the combination of Ishida and Johns is far from obvious. The object of Ishida is to maintain interest when a jackpot is paid out. Johns clearly indicates that a skillful player may be interested in attaining more tickets – one would thus not need the

temptation offered by Ishida. Johns lays out a rationale for the skillful player to continue playing and for the less skillful player to practice.

The Office Action states in summary fashion that the claim elements of claims 1 and 9 are found in Ishida, through reference to Figures 1-9 and accompanying text. With all due respect, this implicates 8 of the 9 sheets of drawings of Ishida, and potentially the entire text of Ishida. Applicants request that if the rejection over Ishida is maintained, a more definite statement of the rejection of claims 1 and 9 be provided.

Applicants note that both of claims 1 and 9 require that the individual games include a microprocessor and software that allows the player to play the game of skill. The Office Action purports to show this in Ishida. However, no specific reference to such a feature is provided in Ishida. Rather, Ishida refers to a control apparatus for game machines (e.g. the Title of Ishida) and it is apparent that there is at least some central control of the slot machines by the central device in Ishida (see, e.g. col. 9, lines 30-45). Thus, the Office Action does not show in Ishida that the required individual games of claims 1 and 9 must be capable of allowing one to play a game of skill at the individual game.

Withdrawal of the 35 U.S.C. § 103(a) is thus respectfully requested.

Some commentary on the rejection of some of the dependent claims may further illuminate the differences between the Ishida reference and the claims. For example, claims 3-4 and 11-12 are rejected in part because Ishida is said to imply use of the standard RS-232 protocol for communication. However, the cited section of Ishida (col. 6, line 8 – col. 7, line 26) refers to a very specific communications protocol and data

format which appears to be proprietary to the Ishida system – unlike the standard RS-232 protocol.

Similarly, claim 5 is rejected on the allegation that Ishida shows that the award is based on one or more criteria as listed in claim 5. The cited section of Ishida (col. 3, line 1 – col. 4, line 50), while covering an entire page of the patent, appears to relate only to accumulation of information about deposited coins, not to awards and criteria for awarding an award.

Moreover, regarding claim 6, the claim is rejected based on col. 5, line 30 – col. 6, line 25 of Ishida, indicating that this section illustrates attainment of a pre-determined goal by a player. However, the only reason for awarding a jackpot mentioned in this section is the type of hit randomly selected. This is the antithesis of a game of skill, where the player attains the goal as a result of skill at play, not a random event effectively controlled by the system.


Applicant submits that the rejection of all claims under section 103 should thus be rescinded, and the claim allowed.

CONCLUSION

Applicant believes that all pending claims are patentable, and respectfully requests an early Notice of Allowance. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,

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